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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,943	03/08/2000	KUBER T. SAMPATH	CIBT-P01-570	7342

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BOSTON, MA 02110-2624

EXAMINER

ANDRES, JANET L

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 04/08/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/423,943

Applicant(s)

SAMPATH ET AL.

Examiner

Janet L. Andres

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 March 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 March 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.


Claim(s) rejected: 1,3,5 and 8-28.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Continuation of 5. does NOT place the application in condition for allowance because: In reference to the rejection of the claims as anticipated by or obvious over Rueger et al., WO 94/03200, Applicant argues that the instant claims specify administration to a site distal or remote from the site of a local defect. Applicant argues that pages 90-93 of Rueger et al. do not meet Applicant's claims because administration in the reference is direct and there is no evidence that the lesion taught by Rueger et al. is available to progenitor cells. Applicant further argues that Rueger et al. teaches morphogens, not candidate morphogens. Applicant's arguments have been fully considered but are not found persuasive. As stated on page 3 of the office action of paper no. 11, Rueger et al. teaches other forms of administration on p. 17 and 55-58. These forms of administration include oral, parenteral, and injection into CSF as well as intravenous, intramuscular, intraorbital, ophthalmic, and other forms (p. 55). Applicant argues that the defects taught by Rueger on pages 90-93 are not permissive as defined in the instant specification; however, on p. 17 of the specification, Applicant indicates that the morphogens can be used to repair "transected or otherwise damaged nerve fibers" and form "form functional replacement neural pathways in the central nervous system". Similar effects are described on pages 18 and 19. The description on p. 2 refers to "damaged neural tissues that may result from physical injury". Thus the lesions taught by Rueger et al. fall within the scope of what the specification sets forth as Applicant's invention. Applicant additionally argues that Rueger et al. does not teach candidate morphogens. However, as stated on p. 3 of the office action of paper no. 11, Rueger et al. teaches candidate morphogens on p. 45. See lines 30-32

In reference to the rejection of the claims as unpatentable over Wang et al., Applicant argues that Wang et al. does not teach candidate morphogens. As stated in the office actions of paper nos. 11 and 14, Wang et al. teaches that other BMPs are inducers of neuronal growth and that BMPs are members of a large family of related molecules. Thus Wang et al. contemplates other molecules than BMP-2, and it would have been obvious to one of ordinary skill in the art to use the method of Wang et al. to evaluate related molecules. One of ordinary skill would have been motivated to do so because one would expect, based on the teachings of Wang et al., to be able to identify other molecules having similar activity using this method.

  
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